

different modes of operation, (3) they have different functions, or (4) they have different effects. (MPEP 806.04, MPEP 808.01). In the instant case, inventions II-III have separate utility such as a method executed on a computing device for determining a product profile of a product, and a computer-implemented method for selecting products that occurs over a networked computer system. See MPEP 806.05(d).

This application has been the subject of appeal to the Board of Patent Appeals and Interferences on two separate occasions. Each time Applicant has submitted an Appeal Brief, the applicant has received an Office Action in response. This Application was filed on April 5, 2000, along with companion applications Serial Nos. 09/543,729; 09/543,837; and 09/521,237. Applicant, due to financial hardship, elected to prosecute claims in the current application and, in response to the action that was mailed on August 19, 2002, added some claims that were related to claims from some of the companion applications. Applicant has consistently cross-cited art from all of the applications and believes that all art cited in the companion applications has been cited in the instant application. On July 28, 2003 Applicant received a final rejection in the subject application.

Applicant contends that this restriction requirement is procedurally flawed.

Divisional practice is governed by 35 U.S.C. 121, which permits, but does not require the Director to require restriction in an application, if: "two or more independent and distinct inventions are claimed in one application." However under 35 U.S.C. 121, no one can question the validity of a patent for failure of the Director to require the application to be restricted to one invention. Thus, divisional practice is provided for administrative convenience.

The patent office promulgated rules to implement divisional practice under 35 U.S.C. 121. One of those rules is 37 CFR 1.142, reproduced below:

37 CFR 1.142. Requirement for restriction.

(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action.

Under 37 CFR 1.142, restriction can be made at any time BEFORE FINAL ACTION. Since the office submitted a final rejection on July 28, 2003, this restriction is procedurally

improper and any attempt to maintain said requirement could be considered to be arbitrary and capricious.

Presumably, after 5 years of pendency, the examiner has already conducted an exhaustive search of the relevant art. In view of Applicant's submission of two Appeal Briefs and cross-citation of art from three related applications, it would be reasonable to conclude that the examiner would not be inconvenienced by examination of the claims presently in the application. The Office responded to the two Appeal Briefs with two office actions that neither cited new art nor advanced new arguments. The Office has delayed the case from being heard by the Board or to be allowed. On the other hand, this delay and protracted prosecution in this application has now become a burden for the applicant.

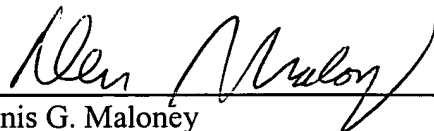
The applicant had previously paid fees for filing for three additional applications, and thus, to the extent that restriction practice is provided to ensure that the Patent Office receives fees commensurate in scope with the work required to properly search an invention, the interests of the office have been already been satisfied and there is no further need to require restriction.

Applicant will elect to prosecute Group 1 claims, but will neither cancel nor indicate claims as being withdrawn until the examiner can adequately explain to Applicant the legality of this restriction requirement.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 12/15/08



Denis G. Maloney
Reg. No. 29,670

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906